

RECEIVED
CENTRAL FAX CENTER

AUG 25 2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10006799-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Borg, et al.

Confirmation No.: 6674

Application No.: 09/820,457

Examiner: Nguyen, Tan D.

Filing Date: 03/28/2001

Group Art Unit: 3629

Title: Systems and Methods for Utilizing Printing Device Data in a Customer Service Center

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 03/07/2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$ 1.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit:

OR

☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300.

Date of facsimile: 8/25/06

Typed Name: Rebekah Glass

Signature: Rebekah Glass

Respectfully submitted,

Borg, et al.

By: David A. Morasch

David A. Morasch

Attorney/Agent for Applicant(s)

Reg No.: 42805

Date: 8/25/06

Telephone: 509-324-9256

RECEIVED
CENTRAL FAX CENTER**AUG 25 2006**
PATENT APPLICATION
Docket No. 10006799-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
)
	BORG, et al.)
)
Serial No.:	09/820,457) Appeal
No.)
)
Confirmation No.	6674)
)
Filed:	March 28, 2001)
)
For:	Systems and Methods for Utilizing Printing)
	Device Data in a Customer Service Center)
)
Examiner:	Nguyen, Tan D.)

The Honorable Commissioner of Patents
Mail Stop Appeal Brief - Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANT

The Appellant has filed a timely Notice of Appeal from the action of the Examiner in finally rejecting all of the claims that were considered in this application. This Reply Brief is being filed under the provisions of 37 C.F.R. § 1.193.

AUG 25 2006

ARGUMENT

1. Examiner under point (6) of the Answer dated 6/30/2006 corrects the Applicant's statement of the ground of rejections to include whether claims 1-19 are obvious over Hardman in view of Klinefelter or Vice Versa. In making out the rejection, the Examiner provides arguments for Hardman in view of Klinefelter or vice versa in a single discussion section (*Final Office Action dated 1/13/2006 p. 4*). Thus, Applicant submits that the previous responses and the submitted appeal brief are responsive to the Examiner's arguments made jointly for Hardman in view of Klinefelter or vice versa. The arguments directed to Hardman in view of Klinefelter are applicable to Klinefelter in view of Hardman. The vice versa was inadvertently left out in stating the grounds of rejection in the Appeal brief and the Applicant appreciates the Examiner's correction. Thus, Applicant hereby submits that the correct statement of the grounds of rejection to be reviewed is whether Claims 1-19 are unpatentable under 35 U.S.C. § 103 as being obvious over U.S. Published Patent Application No. 2002/0075145 to Hardman et al. (hereinafter "Hardman") in view of U.S. Patent No. 6,386,772 to Klinefelter et al. (hereinafter "Klinefelter") or vice versa.

2. Examiner indicates in the Answer that the replaceable item and printing device are not positively recited and thus receive little patentable weight. *Answer dated 6/30/2006 p. 4*. In numerous, other places the Examiner characterizes language from the claims as non-essential to the invention. (for example: in the rejection of each of claims 2 to 9 *Answer, p. 7-9*; Response to Appellants Arguments, *Answer, p.12-14*). Applicant disagrees and again submits that the Examiner is not free to ignore recited features of the claims.

For example, Claim 1 recites a method that includes “retrieving printing device data from component memory of a replaceable component from a printing device used by a customer; storing the printing device data in a customer database”. Thus, claim 1 recites “retrieving . . . from a printing device used by a customer” which positively recites a printing device involved in the performance of the “retrieving”. Further, claim 1 recites retrieving printing device data from component memory of a replaceable component and a replaceable component which positively recites a replaceable component involved in the performance of the “retrieving”. Therefore, this is functional language and the Examiner is not free to ignore this feature.

Features of a “printing device” and “component memory, are also recited in Independent claims 10 and 16.

Claim 10 recites a system that includes “printing device replaceable

component including component memory integrated therewith”, “a customer database that stores customer information for multiple customers, including printing devices and printing device replaceable components used by the customers”, and “printing device data is retrieved from the component memory and stored in the customer database”.

Claim 16 recites a method that includes “printing devices that use replaceable components with integrated component memory” and “compiling data retrieved from the component memory of a plurality of replaceable components into a customer database”. Thus, contrary to the Examiner’s conclusion that the replaceable item and printing device are not positively recited, each independent claim does recite these features. The Applicant’s invention in the case of each claim includes everything which is recited in the claim. Contrary to the Examiner’s assertion, the recited features further define the claimed invention and are essential. Recited features may not simply be dismissed.

3. Further, the Examiner’s Response to Appellants Arguments, *Answer dated 6/30/2006, p.12-14* still has not explained why a person of ordinary skill in the art, when viewing the references, would be motivated to combine them in the required manner. In other words, why the tire monitoring methods and techniques of Hardman would be combined with the internal data method for a printer described in Klinefelter. The Examiner appears to merely rely upon the assertion that the combination is within the skill of the artisan, repeating a previous statement that:

To an Engineer, the application of the same electronic data collection, monitor and problem identification (diagnostics) of a device using RFID tag system to any devices of different functions, for printing, copying, moving, heating, calculating, etc. are within the skill of the artisan. In fact, the functions of the device are non-essential and within the skill of the artisan to make minor adjustments to the specific device to carry out the main goal of electronic data collection, monitor, and problem identification (diagnostics) of a device using RFID tag. *Answer dated 6/30/2006, p. 14.*

In response, the Applicant again respectfully asserts that the Examiner has applied an improper standard. It appears that the Examiner has based the obviousness determination on the fact that the proposed modifications are within the skill of the artisan and after improperly ignoring features recited in the claims. Even assuming for the sake of argument that the prior art references teach all the claimed features, the fact that references may be combined, or that the combination is within the skill of an artisan is insufficient to establish a *prima facie* case of obviousness. MPEP §2143.0 for instance describes:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); MPEP § 2143.0.

The Examiner's conclusion here that the proposed modifications were within the skill

of the artisan does not relieve the Examiner of the obligation to provide some objective reason to combine the teachings of the references.

As noted above, the claims in the subject Application recite printer device data, a printer device, and a replaceable component from the printer device. The Application relates generally to managing data collected from printing devices and more particularly to retrieving data from printing device components that have memory and utilizing the printing device data to provide improved customer service.

However, Hardman limits its own scope to tire monitoring. Hardman repeatedly refers to “tire tags”, “tire data”, and defines the system as “Electronic Tire tag Management System (ETMS)” and does not disclose any other contemplated use. The broad grouping under “electronic data collection” is simply too attenuated to support the use of the Hardman reference against the instant Application. Nowhere in Hardman is there disclosure, teaching or suggestion of printing devices, printers, printer data, or the like. Hardman does not describe any other use besides tire monitoring. Tires and printers are significantly different fields which the ordinary artisan would not logically link. Therefore, an artisan in the Applicant’s field of endeavor seeking to manage data collected from printing device simply would not look to a tire monitoring system as described in Hardman.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed

invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (*Bd. Pat. App. & Inter.* 1985)(emphasis added). Here, however, the Examiner has failed to provide a convincing line of reasoning as to why Hardman and Klinefelter would be combined in the required manner. Rather reliance is placed on the assertion that the combination is within the skill of an artisan which is not sufficient.

4. Further, the §103 rejection of claims 1-19 is not proper because Hardman and Klinefelter, alone or in combination, fail to teach or suggest all the recited features of claim 1-19. It is once again respectfully submitted that the combination of references suggested by the Office herein rejecting the above referenced claims is defective.

The Examiner states “Hardman et. al fairly discloses the claimed invention except for the difference in the function/capability of the device, i.e. printing in printing device.” *Answer dated 6/30/2006*, p. 6. Applicant understands Examiner’s statement and rejection under §103 as acknowledging that Hardman fails to teach recited printer features of the claims such as printer device data, printer device and replaceable component from a printer device.

To correct the defects in Hardman, and more particularly the absence in

Hardman of any mention whatsoever of a device other than a tire, the Examiner asserts Klinefelter. However, the combination of Klinefelter with Hardman would not produce the claimed invention. Klinefelter describes communication of information within an electronic printer. For example, a make and supplier of a ribbon may be included in a memory of the ribbon such that operation of a print head may be optimized by communicating this information from the ribbon to the electronic printer. *Klinefelter*, col. 5, Lines 60-67. Thus, the information communicated within Klinefelter serves the sole purpose of informing the printer of materials being used and does not teach or suggest the recited method. The Examiner even describes Klinefelter as having the “goal of communicating between a printer/printing device and supplies” *Answer dated 6/30/2006*, p. 6. Klinefelter does not teach or suggest any other use of the data. Communicating between components of a printer is not equivalent to the claimed invention as recited in claim 1, for example. Accordingly, Klinefelter and Hardman, alone or in combination, fail to teach or suggest at least “storing the printing device data in a customer database”; “associating the printing device data with the customer”, and “accessing the printing device data in the customer database to assist the customer with solving problems related to the printing device” in claim 1. Thus, the combination does not teach or suggest all the claimed features. For the reasons previously submitted the proposed combination of Hardman and Klinefelter lacks sufficient motivation.

5. Further, the proposed combination of Hardman and Klinefelter lacks sufficient motivation because the proposed modification would alter the principle of operation and/or intended purpose of Klinefelter, namely the acknowledged goal of communicating between a printer/printing device and supplies (ribbon) and the associated techniques described in Klinefelter to accomplish the goal. Klinefelter describes directly communicating data between the supply (ribbon) and printing device. No intermediate database or storage is employed in Klinefelter. In fact Klinefelter describes direct communication between a supply (ribbon) and a microprocessor. *Klinefelter*, col. 3 lines 33-38. Thus, if the combination was limited to communicating internally between components of a printer as in Klinefelter, then this is not equivalent to the claimed invention. On the other hand, a modification resulting in “storing the printing device data in a customer database”, “associating the printing device data with the customer”, and “accessing the printing device data in the customer database to assist the customer with solving problems related to the printing device” as in claim 1, fails to accomplish the acknowledged objective of Klinefelter to communicate data between components of a printer. Thus, the proposed modification would render Klinefelter unfit for its intended purpose and/or alter the principles of operation of Klinefelter.

6. In response to the Examiner's assertion that the References have been argued individually (*Answer, p. 15 point 6*), the Applicant disagrees and makes reference to the Appeal Brief dated 5/5/06 which clearly argues the combination of references, the deficiencies in the proposed combination of references, the lack of motivation for the combination of references, and so forth. As one example, point 2 in the Appeal Brief is titled "The §103 rejection of claims 1-19 is not proper because Hardman and Klinefelter, *alone or in combination*, fail to teach or suggest all the recited features of claim 1-19. (emphasis added)". Thus, the Examiner's assertion that the references are argued individually has no basis.

RECEIVED
CENTRAL FAX CENTER

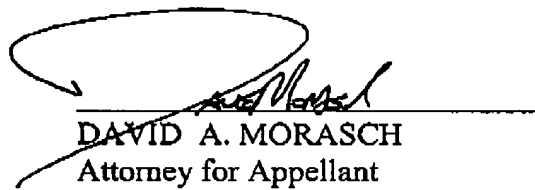
AUG 25 2006

CONCLUSION

The Appellant respectfully considers this application to be in condition for allowance and respectfully requests the Board to overturn the final rejection and that the Examiner pass this application to allowance.

Dated this 25 day of Aug, 2006.

Respectfully submitted,



DAVID A. MORASCH
Attorney for Appellant
Registration No. 42,905

LEE & HAYES PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201
Telephone: (509) 324-9256 (Ext. 210)
Facsimile: (509) 323-8979